



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,071	02/08/2002	Jens Erik Sorensen	52-173	3616
22653	7590	12/27/2005	EXAMINER	
EDWARD W CALLAN NO. 705 PMB 452 3830 VALLEY CENTRE DRIVE SAN DIEGO, CA 92130			MOONEYHAM, JANICE A	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/072,071	Applicant(s) SORENSEN ET AL.	
	Examiner Janice A. Mooneyham	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-39, 41-43, and 52-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-39, 41-43 and 52-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the applicant's communication filed on December 5, 2005, wherein:

Claims 36-39, 41-43, and 52-67 are pending;

Claims 36-37, 39, 41-42 have been amended;

Claims 40 and 44-51 have been canceled;

Claims 52-67 have been added.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 5, 2001 has been entered.

Specification and Drawings

3. The amendment filed December 5, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The applicant has amended the specification and drawing to add in language that is in the amended claims. This is considered to be new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 36-39, 41-43, and 52-67 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant has amended the claim language to read *causing a computer system to execute instructions that cause accumulation of idea contributions and causing a computer system to execute instructions that cause the assignment of contingent contractual rights*. The Examiner request that the applicant direct the Examiner to where there is disclosure for causing the computer to execute instructions that cause accumulation of idea contributions and causing the system to execute instructions that cause the assignment of contingent contractual rights. In the claims, applicant claims *causing the computer system to execute instruction that cause at least some of the contractual rights to be marketed?* Where is this in the specification? Also, claim 39 reads *causing the computer system to execute instructions* that cause online transfer, sale and/or auction. Where is this in the specification? Claim 41 reads *causing the computer system to execute instructions* that cause said contingent contractual rights to a portion of income from said property rights to be assigned. Where is this disclosed in the specification.

Art Unit: 3629

5. Claims 36-49, 41-43, and 52-67 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. How do the instructions cause the assignment of contingent contractual rights?

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 36-49, 41-43, 52-67 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The applicant has amended the claim language to read ***causing a computer system to execute instructions that cause accumulation of idea contributions.***

What does the applicant mean by the word *causing*? Does a person cause the computer to execute instructions? Then does a person input idea contributions into the database? Or is applicant trying to claim software that when executed causes the computer to perform steps? Executing instructions can be sending an email with instructions.

The applicant has amended the language to read ***causing the computer system to execute instructions that cause the assignment of contingent***

Art Unit: 3629

contractual rights to contributors of the idea contributions... Does the computer email instructions to someone? What does the language *cause the assignment mean*?

The applicant has amended the claim language to read ***marketing at least some contractual rights under said assigned contingent contractual rights to a portion of income from said property rights.*** What does the language *to a portion of income from said property rights* mean?

Claims 38-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. What does the term marketed in an online marketable format mean? What does the applicant mean by the format is an electronically tradable certificate?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 36-39, 41-43 and 52-67 are rejected under 35 U.S.C. 102(e) as being anticipated by Powell (US 2004/00220881 (hereinafter referred to as Powell)).

Referring to Claims 36, 54-56, 57-59 and 63-65:

Powell discloses a method and program for managing ideas for prospectively patentable inventions, comprising the steps of

maintaining a computer database for accumulating ideas for prospectively patentable inventions (Fig. 2- FDI (Fully Disclosed Idea) Database (261) and NDS (FDI) (non-disclosing synopsis of an originator's fully disclosed idea Database 260) page 8 [0088, 0091, 0092, 0093] [0100], page 10 [0111] and [0112]) system to allow communication of ideas to potential users); and

programming a computer to provide contingent (*as defined by Black's Law Dictionary is possible, but not assured, doubtful or uncertain, conditioned upon the occurrence of some future event which is itself uncertain or questionable*) contractual rights in exchange for transfers of property rights under patent rights to prospectively patentable inventions derived at least in part from the accumulated ideas (*users desiring to commercially exploit or otherwise utilize the originator's fully disclosed idea will negotiate directly with the originator for an exclusive or nonexclusive license, option, preemptive right or assignment of the idea*[0015]; *an originator who desires to post, license or sell an idea* [0018]; *in the event that a user decides not to license, purchase or otherwise acquire the rights (contingent)*), or in exchange for contractual obligations to transfer the property rights wherein the rights are to a portion of anticipated income derived from said property rights (*this body of law enforces contractual obligations to pay the originator of a creative idea for its use* [0079]; *that use will not be made thereof unless there is appropriate payment by the producer or studio* [0081] toy example – it

*is common practice for toy developers to "pitch" their ideas and concepts to toy marketing companies prior to reduction to practice (**prospectively patentable invention**) in exchange for this opportunity, the toy company agrees to pay a royalty on all products sold deriving from the original idea. The toy company is paying the originator for the opportunity to bring the idea to market and obtain exclusive marketing rights to the initial product and **derivatives thereof** [0082] [0088] innovation transfer protocols; originator would like to be compensated for use of the idea; although the originator may have inchoate intellectual property rights (e.g., patent, copyright, trade secret or other statutory property rights) (abstract, Figure 12a, 13, 18a, 19, page 1 [0008], page 2 [0012-0015, page 7 [0082], page 17 [00191] Revenue Generation; pages 18-19 FDI: Toy Concept [0201], pages 19-21 [0203-0212]; and*

*marketing the contingent contractual rights (the toy company is paying the originator for the first opportunity to bring the idea to market and obtain exclusive marketing rights to the initial product and **derivatives thereof** [0082].*

Referring to Claims 37 and 60:

Powell discloses programming a computer to facilitate marketing of the rights in an online marketable format ((0015] *users desiring to commercially exploit or otherwise utilize the originator's fully disclosed idea will negotiate directly for an exclusive or nonexclusive license, option, preemptive right or assignment of the idea utilizing electronically or web-enabled communication means*) see also page 2 [0012]).

Referring to Claims 38, 61 and 66:

Powell discloses the format being an electronically tradable certificate (*Black's Law Dictionary defines a certificate as a written assurance or official representation that some act has or has not been done or some event occurred, or some legal formality has been complied with, thus a license would be a certificate*) ([0015] *users desiring to commercially exploit or otherwise utilize the originator's fully disclosed idea will negotiate directly for an exclusive or nonexclusive license, option, preemptive right or assignment of the idea utilizing **electronically or web-enabled communication means***) see also page 3 [0024] and assignment or license can be transferred, page 14 [0016]).

Referring to Claims 39, 62 and 67:

Powell discloses enabling an online transfer, sale, and/or auction of the rights ([0018] *an originator who desires to post, license or sell an idea, the system is an online commercial network [0012]*) see also page 3 [0024-0025]).

Referring to Claim 41:

Powell discloses facilitating online contributions of ideas ([0012] *facilitate idea submission; the present invention is a method and apparatus for effectuating bilateral commerce of ideas, the system is an online commercial network [0012]*); and

providing contractual rights via an online communication network between the computers ([0012] *the present invention is both an originator and user-driven online commercial network system designed to facilitate idea submission, purchase and licensing, also [0015] exclusive or nonexclusive license, option, preemptive right or*

Art Unit: 3629

assignment can be negotiated electronically or in a web-enabled communication means).

Referring to Claims 42:

Powell discloses accumulating ideas prior to filing a patent application (*it is common practice for toy developers to "pitch" their ideas and concepts to toy marketing companies **prior to reduction to practice** ([0082] see also page 18 [0201 thru page 21 [0214]).*

Referring to Claims 43:

Powell discloses the ideas include needs or requirements of the invention ([0235-0237] *see abstract- the invention allows users to communicate unsolved problems or needs globally to potential originators, for originators to search for relevant unsolved problems or needs and for originators to submit and communicate proposed solutions)*

Response to Arguments

Applicant's arguments filed December 5, 2005 have been fully considered but they are not persuasive.

The applicant argues that Powell does not disclose marketing of ***assigned*** contractual rights to a portion of anticipated income derived from property rights under patent rights. The Examiner respectfully disagrees.

First of all, the applicant has identified step (b) of claim 36 as:

b) programming a computer to provide contingent contractual rights in exchange for transfers of property rights under patent rights to prospectively patentable inventions derived at least in part from the accumulated ideas or in exchange for contractual obligations to transfer said property rights, wherein said contingent contractual rights are to a portion of anticipated income derived from said property rights.

Powell discloses marketing the contractual rights (*the toy company is paying the originator for the first opportunity to bring the idea to market and obtain exclusive marketing rights to the initial product and **derivatives thereof*** [0082]).

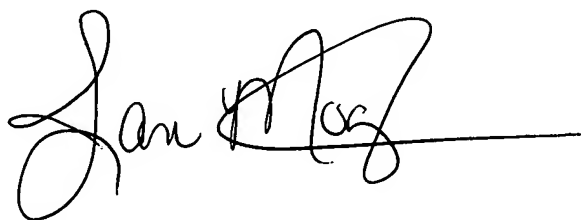
The fact that the rights are assigned contractual rights is determined to non-functional descriptive data which does not functionally relate to the steps of the method. The method would be performed the same regardless of what you call the contract rights. See *In re Gulack*, 703 F.2d. 1381, 1385, 217 USPQ 401, 404.

Art Unit: 3629

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Jan Mooneyham", with a long horizontal line extending to the right.

Jan Mooneyham
Patent Examiner
Art Unit 3629